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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,227	12/08/2003	Brian D. Goodman	POU920020089US2	2489

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IBM Corporation  
Intellectual Property Law  
2455 South Road, P386  
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EXAMINER
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PATEL, DHAIRYA A

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/730,227

Applicant(s)

GOODMAN ET AL.

Examiner

Dhairya A. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/8/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Application # 10/730,227 was filed on 12/8/2003. Claims 1-29 are presented for examination.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Wu et al. U.S. Patent Publication # 2002/0023131 (hereinafter Wu).

As per claim 1, Wu teaches a method for electronic instant message conversation, the method comprising the steps of:

-receiving at a second client (Fig. 6 element 602b, 630), a first message from a first client (Fig. 6 element 602a, 605), the first client having a first network address (Paragraph 67)

The reference teaches the message includes the screen name, IP address of the sender/recipient.

-creating at the second client, a second message (claim 1,10,12), the second message comprising the first message and the first network address (claim 1,10,12,14,15);

The reference teaches sending a request (message) from the recipient (second client) including the IP address (first network address) associated with the sender and recipient.

-transmitting the second message by way of an instant message application from the second client to the first client (claim 10,12,14,15);

The reference teaches sending the request to the sender from the instant messaging host and authenticating the request comprises identifying the screen name associated with the at least one of the sender and the recipient. Therefore it is inherent that since the request is identified by the screen name, it is using an instant messaging application because screen name are typically used in instant messages.

-retrieving additional information related to the second client (claim 8); and

The reference claim teaches that reporting the capabilities of the recipient (additional information related to the second client) to the sender.

-presenting the second message and the additional information at the first client(claim 8) (claim 10,12,14,15)

The reference claim teaches that reporting the capabilities of the recipient (additional information related to the second client) to the sender.

As per claim 2, Wu teaches the method according to claim 1 wherein the first message is a published message received from a Publish/Subscribe server (Paragraph 63).

The reference teaches sending the request to the host containing the subscriber's information and verifying it with the information stored in the subscriber database server.

As per claim 3, Wu teaches the method according to claim 1 comprising the further step of subscribing, by any one of the first client or the second client, to a publish/subscribe server (Paragraph 63).

The reference teaches sending a request to the host from both the first and the second client containing the subscriber's information and verifying it with the information stored in the subscriber database server.

As per claim 4, Wu teaches the method according to claim 1 wherein the additional information comprises any one of a first user name, first user title, first user address, first user telephone number, first user value, first user job responsibility, first user secretary, a text file, a video file, an audio file or a network link (such as a URL) (Paragraph 70,71)

The reference teaches having additional information such as if the user is talk-enabled displaying (sending) a talk enabled button, which will enable an audio.

As per claim 5, Wu teaches the method according to claim 1 wherein any one of the first message or the second message is translated to any one of a telephone

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message, a video display, an audio message or a mechanical actuator(Paragraph 70,71).

The reference teaches the second message is translated into an audio message.

As per claim 6, Wu teaches a method for identifying a message initiator in a system for instant message using a pub/sub server, the method comprising the steps of:

- obtaining at a first client, first user identifying information (Fig. 7 element 700);

The figure teaches obtaining at the first client, a message sent to the second client and also first user's screen name (first user identifying information).

- incorporating the first user identifying information in a message to be published; transmitting the message to a pub/sub server(Paragraph 63);

The reference teaches sending a request with the first user identifying information such as screen name in the request and sending it to the subscriber database server.

- publishing the message to subscribers of the pub/sub server; and providing the message comprising the first user information to a subscriber (Paragraph 63)(Fig. 7)(Fig. 8).

The reference teaching sending the message to the second client (subscriber) of the first user information including screen name. The figure also teaches sending a message to the second client (subscriber) and displaying "start talk" button and "connect" button (information about first user) because since the button is there that means that first user and second user has equipment to engage in talk conversation.

As per claim 7, Wu teaches the method according to claim 6 wherein the providing step comprises the further steps of: acquiring second user information based on the first user identifying information in the message (Paragraph 69,70); and

The reference teaches acquiring information of the second user, which it is talk enabled as in has both the talk software and the audio equipment.

-providing the second user information to the subscriber (Paragraph 69,70).

The reference teaches providing a start talk UI button to the first user (subscriber) if the second user is talk enabled (user information).

As per claim 8, Wu teaches the method according to claim 6 wherein the obtaining step comprises the further step of: transforming user information from any one of instant message, text, audio, video or voice into the digital message (Paragraph 73,70).

The reference teaches using the user information to transformation the instant message into an audio message.

As per claim 9, Wu teaches the method according to claim 6 wherein the presenting step comprises the further step of: transforming the message to any one of instant message, text, audio or video (Paragraph 73,70).

The reference teaches using the user information to transformation the instant message into an audio message.

As per claim 10, Wu teaches a method for electronic instant message conversation, the method comprising the steps of:

-creating at a first client, a first message, the first message comprising any one of additional information or a link to additional information, the additional information comprising any one of a user title, a user telephone number, a user value, a user job responsibility, information about a user's secretary, a text file, a video file, an audio file, a network link such as a URL, a telephone message or command information for actuating a mechanical device (Paragraph 66 lines 6-12)(Paragraph 68)(Paragraph 69);

The reference teaches sending the a message which contains user information such as a screen name and also command information for actuating a mechanical device which is start a talk using talk software and audio equipment.

-transmitting the first message by way of an instant message application from the first client to a second client (Paragraph 67)(Paragraph 69)(Paragraph 70 lines 1-9)(Fig. 6);

The reference teaches sending an instant message from first client to the second client.

-retrieving at the second client, the additional information (Paragraph 69)(Paragraph 70)(Paragraph 71); and

The reference teaches displaying "start talk" or "start talk UI" buttons on the second client's UI or first client's UI depending on the capabilities of the sender and/or recipient, capabilities depending on the talk software and audio equipment.

-presenting the first message and the additional information at the first client (Fig. 700).



The figure teaches sending a message to the second client and displaying the first message as in "hello talkster1" and also "start talk" additional information on the first client's UI.

As per claims 11-15 respectively, teaches same limitations as claims 1-5 respectively, therefore rejected under same basis.

As per claims 16-19 respectively, teaches same limitations as claims 6-9 respectively, therefore rejected under same basis.

As per claim 20 respectively, teaches same limitations as claim 10 respectively, therefore rejected under same basis.

As per claim 21, Wu teaches a system for electronic instant message conversation, the system comprising:

- a network (Fig. 1 element 160);
- a first client in communication with the network (Fig. 6 element 602a, 605);
- a second client in communication with the network, wherein the clients include instructions to execute a method comprising (Fig. Element 602b,630):

- receiving at a second client (Fig. 6 element 602b,630), a first message from a first client(Fig. 6 element 602a,605), the first client having a first network address (Paragraph 67)

The reference teaches the message includes the screen name, IP address of the sender/recipient.

-creating at the second client, a second message (claim 1,10,12), the second message comprising the first message and the first network address (claim 1,10,12,14,15);

The reference teaches sending a request (message) from the recipient (second client) including the IP address (first network address) associated with the sender and recipient.

-transmitting the second message by way of an instant message application from the second client to the first client (claim 10,12,14,15);

The reference teaches sending the request to the sender from the instant messaging host and authenticating the request comprises identifying the screen name associated with the at least one of the sender and the recipient. Therefore it is inherent that since the request is identified by the screen name, it is using an instant messaging application because screen name are typically used in instant messages.

-retrieving additional information related to the second client (claim 8); and

The reference claim teaches that reporting the capabilities of the recipient (additional information related to the second client) to the sender.

-presenting the second message and the additional information at the first client(claim 8) (claim 10,12,14,15)

The reference claim teaches that reporting the capabilities of the recipient (additional information related to the second client) to the sender.

As per claims 22-24 respectively, teaches same limitations as claims 2,4-5 respectively, therefore rejected under same basis.

As per claim 25, Wu teaches a system for identifying a message initiator in a system for instant message using a pub/sub server, the system comprising:

- a network(Fig. 1 element 160);
  - a pub/sub server (Fig. 5 element 5902,5912,5914);
  - a first client in communication with the network, wherein the clients include instructions to execute a method comprising (Fig. 6 element 602a, 605):
    - obtaining at a first client, first user identifying information (Fig. 7 element 700);
- The figure teaches obtaining at the first client, a message sent to the second client and also first user's screen name (first user identifying information).
- incorporating the first user identifying information in a message to be published;
- transmitting the message to a pub/sub server(Paragraph 63);

The reference teaches sending a request with the first user identifying information such as screen name in the request and sending it to the subscriber database server.

-publishing the message to subscribers of the pub/sub server; and providing the message comprising the first user information to a subscriber (Paragraph 63)(Fig. 7)(Fig. 8).

The reference teaching sending the message to the second client (subscriber) of the first user information including screen name. The figure also teaches sending a message to the second client (subscriber) and displaying "start talk" button and "connect" button (information about first user) because since the button is there that means that first user and second user has equipment to engage in talk conversation.

As per claims 26-28 respectively, teaches same limitations as claims 7-9 respectively, therefore rejected under same basis.

As per claim 29, Wu teaches a system for electronic instant message conversation, the system comprising:

- a network (Fig. 1 element 160);
- a pub/sub server (Fig. 5 element 5902,5912,5914);
- a first client in communication with the network, wherein the clients include instructions to execute a method comprising (Fig. 6 element 602a, 605):

- creating at a first client, a first message, the first message comprising any one of additional information or a link to additional information, the additional information comprising any one of a user title, a user telephone number, a user value, a user job responsibility, information about a user's secretary, a text file, a video file, an audio file, a network link such as a URL, a telephone message or command information for actuating a mechanical device (Paragraph 66 lines 6-12)(Paragraph 68)(Paragraph 69);

The reference teaches sending the a message which contains user information such as a screen name and also command information for actuating a mechanical device which is start a talk using talk software and audio equipment.

- transmitting the first message by way of an instant message application from the first client to a second client (Paragraph 67)(Paragraph 69)(Paragraph 70 lines 1-9)(Fig. 6);

The reference teaches sending an instant message from first client to the second client.

-retrieving at the second client, the additional information (Paragraph 69)(Paragraph 70)(Paragraph 71); and

The reference teaches displaying "start talk" or "start talk UI" buttons on the second client's UI or first client's UI depending on the capabilities of the sender and/or recipient, capabilities depending on the talk software and audio equipment.

-presenting the first message and the additional information at the first client (Fig. 700).

The figure teaches sending a message to the second client and displaying the first message as in "hello talkster1" and also "start talk" additional information on the first client's UI.

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A). "Voice Instant messaging" by Wu et al. U.S. Patent Publication # 2002/0023131 A1.

B) "Video Messaging" by Enete et al. U.S. Patent Publication # 2003/0208543 A1.

4. A shortened statutory period for response to this action is set to expire **3 (three) Months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the applicant (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).


5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhairya A. Patel whose telephone number is 571-272-5809. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAP

  
**ZARNI MAUNG**  
**SUPERVISORY PATENT EXAMINER**